

REMARKS

This responds to the Office Action mailed on October 3, 2006.

Claim 8 is amended, claims 1-7 were previously canceled without prejudice to the Applicants; as a result, claims 8-24 are presently pending in this application.

Applicants have made amendments to the figures and claim 8 to overcome informalities in objections raised by the Examiner. Therefore, entry of these amendments is appropriate.

Claim Objections

Claim 8 was objected to for some minor informalities, which have been corrected by this amendment. Thus, these objections are no longer appropriate and should be withdrawn.

§103 Rejection of the Claims

Claims 8-12, 15-18 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brill et al. (U.S. 2004/0254920) in view of Colace et al. (U.S. 6,826,572). To sustain an obviousness rejection each and every step or element in the rejected claims must be taught or suggested in the proposed combination of references. Moreover, there must be some demonstrable evidence to suggest that one of ordinary skill in the art would have been motivated to make the proposed combination in the first instance.

Applicants would further like to point out that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art recited also suggests in some manner the desirability of the proposed combination. *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). Applicants would also like to note that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); *Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998). This requirement is rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision making, as it is in 35 U.S.C. § 103. *See id.*, at 1344-45.” *In re Kahn*, No. 04-1616 (Fed. Cir. March 22, 2006).

It has also been held that when the primary teachings of one reference is negated or taught against or teach away from another reference in the proposed combination, then it is common sense that one of ordinary skill in the art would not have been motivated to combine the references in the manner being proposed, because in so doing the very teachings that are asserted

to be complimentary are by definition not complimentary to one another. Thus, there is no motivation by one of ordinary skill in the art to combine the references. It is also the case that the intended functions of the references being combined cannot be destroyed when combined. *See In re Grasselli*, 713 F.2d 731, 743; 218 USPQ 769, 779 (Fed. Cir. 1983).

With this in mind Applicants respectfully objects to the proposed combination being issued by the Examiner.

Specifically, the Brill reference is directed to mining search logs to enhance or augment an existing search by supplying synonyms, spelling corrections, spelling variations, etc. See Brill, Abstract last two sentences and paragraphs 9 and 11 among others. The Brill reference does not generate a new search it augments a search based on a generated profile.

Conversely, the Colace reference is directed to providing tools to WWW sellers to manage their listings that they are offering for sale. The references cited by the Examiner for Colace refer to a power seller searching and managing his/her listings.

First, the subset of space within which the Colace reference is well defined and well known in advance. It is the information associated with a particular seller and his/her listings for products or services being offered for sale over the WWW. This is a well defined area or space of information. Consequently, the entire discussion of Colace uses menu driven operations with limited options to navigate and steer the seller to get views of the listings. There would be no need or desire by one of ordinary skill in the art to combine Brill with Colace because Brill is focused on providing a robust augmenting search to improve recall of search, whereas Colace is focused on improving precision of a menu drive search because the known universe of data for the search (recall) is readily known and defined simply by virtue of the sellers id. Brill is focused on recall and Colace on precision; one of ordinary skill in the art would not have combined the two in the manner proposed by the Examiner because precision and recall are not compatible meaning as recall increases precision decreases and vice versa. So, implementing Brill with Colace would degrade the precision of Colace and implementing Colace with Brill would degrade the recall of Brill. One of ordinary skill in the art would recognize this distinction between a recall based approach and a precision based approach and would not have been motivated to combine the two. Thus, Applicants assert that the motivation to combine does not exist.

Additionally, Applicants would like to point out that in Colace there is no generated search. It is the user that entirely generates the search via the menu. In other words there is no automatic search generation; just automatic search results are gathered and presented. Finally,

Colace is not at all focused on analyzing search logs or histories; the focus is on transactions and listings against products or services of the seller; conversely Brill is exclusively focused on search logs or histories. Applicants fail to see how one of ordinary skill in the art would be motivated to combine these two in the manner proposed by the Examiner, since in so doing Brill would have restrictive user search capabilities (menu driven and limited to defined universe) and Colace would have irrelevant expansion of searches (searches in Colace are done by the power seller).

Accordingly, Applicants believe the two references cannot be combined in the manner proposed by the Examiner because the two are not related and because if the two are combined the very benefits and purposes of each of the teachings in the references are lost or negated. Thus, Applicants respectfully request that the rejections be withdrawn and the claims allowed.

Claims 13 and 22-24 were rejected under 35 USC § 103(a) as being unpatentable over Brill in view of Colace, and further in view of DeLorme et al. (U.S. 5,948,040). Each of the rejected claims are dependent upon independent claims. Therefore, allowance of these claims is appropriate if the independent claims from which they depend are allowed. Applicants submit that the remarks above are sufficient to permit the independent claims to be allowed; therefore, the rejections of claims 13 and 22-24 should be withdrawn.

Claims 14 and 19-20 were rejected under 35 USC § 103(a) as being unpatentable over Chakraborti et al. (U.S. 6,334,131).

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

Respectfully submitted,

MICHAEL CHAVES ET AL.

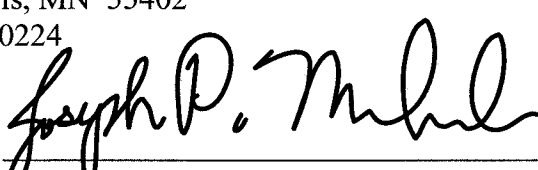
By their Representatives,

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Date 1/5/2007

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5th day of January 2007.

Kimberly Brown

Name


Signature